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REMARKS

Claims 1-31 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 23-31 Under 35 U.S.C §112

Claims 23-31 stand rejected under 35 U.S.C §112, second paragraph, because the Examiner states that it is not clear which *means for providing* is being claimed. In the Reply to Office Action dated September 22, 2004, independent claim 23 was amended and now recites *means for providing rotary movement of a moveable member about a central axis and linear movement of the moveable member along the central axis*. Thus, it is clear that the dependent claims that recite *the means for providing* refer to providing both rotary and linear movement with respect to a central axis. In view of at least the foregoing comments, this rejection should be withdrawn.

II. Rejection of Claims 1-7 and 10-19 Under 35 U.S.C. §102(b)

Claims 1-7 and 10-19 stand rejected under 35 U.S.C. §102(b) as being anticipated by Weingartner (US 4,462,467). Applicant's representative respectfully requests that this rejection be withdrawn for at least the following reasons. Weingartner fails to disclose each and every limitation set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes **each and every limitation** set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *The identical invention must be shown in as complete detail as is contained in the ... claim.* *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added).

The claimed invention relates to a linear/rotary actuator that operates on a moveable member to aid in controlling the operation of an associated tool. In particular, independent claims 1 and 12 recite similar limitations, namely *a moveable member having a length that*

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moves in a rotary motion about a central axis and a linear motion along the central axis to position an associated drive member. Weingartner is silent regarding such novel aspects of the subject claims.

Instead, Weingartner relates to a percussion drill machine that imparts percussive force to a drilling tool. The cited reference employs a free piston that imparts the force to drive an associated rod member to facilitate the operation of an associated tool. In the Final Office Action, the Examiner incorrectly equates the free piston of Weingartner to the *moveable member*, as claimed. The Examiner supports this mistaken contention by stating that the free piston is positioned in such a way so as to drive the associated drive member forward. However, such an interpretation misconstrues the claimed aspect of the *moveable member* employed to *position an associated drive member*. As an example to further illustrate this distinction, the claimed invention allows for activating rotary and/or linear windings to facilitate control of the moveable member. A drive member is attached to the moveable member in such a way that the drive member moves linearly commensurate with the moveable member. Thus, the claimed invention employs the moveable member to allow for positioning the associated drive member to facilitate accurate operation of an associated tool. To the contrary, Weingartner employs the free piston simply to drive an associated drive member forward for the purpose of operating an associated tool. Thus, the reference fails to disclose *a moveable member that moves... to position an associated drive member*, as claimed.

Moreover, Weingartner employs both the free piston and the rod drive member along the same axis. Thus, the cited reference fails to disclose the claimed *limitation of a moveable member...that moves in a rotary motion about a central axis and a linear motion along the central axis...and a drive member that is parallel to the central axis*.

The Examiner is reminded that the standard by which anticipation is to be measured is *strict identity* between the cited document and the invention as claimed, not mere equivalence or similarity. *See, Richardson* at 9 USPQ2d 1913, 1920. Weingartner fails in this respect; thus the rejection with respect to independent claims 1 and 12 (and the claims that depend there from) should be withdrawn.

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III. Rejection of Claims 8, 9 and 20-22 Under 35 U.S.C. §103(a)

Claims 8, 9 and 20-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Weingartner in view of Riello *et al.* (US 6,216,798). Withdrawal of this rejection is requested for at least the following reasons. The cited references, alone or in combination, do not teach or suggest every limitation of the subject claims.

Claims 8 and 9 depend from independent claim 1 and claims 20-22 depend from independent claim 12. As discussed *supra*, Weingartner fails to disclose *a moveable member...that moves in a rotary motion about a central axis and a linear motion along a central axis to position an associated drive member*. Riello *et al.* fails to compensate for the deficiencies of Weingartner. Rather, Riello *et al.* concerns work units for automatic machine tools in which a spindle moves in translation and rotates with respect to a work axis for operation of an associated tool. However, Riello *et al.* does not employ any type of a moveable member for positioning the spindle for operation of the tool.

In view of at least the foregoing, it is readily apparent that Weingartner and Riello *et al.* do not teach or suggest all limitations of the subject claims. Accordingly, this rejection should be withdrawn.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [ALBRP241USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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